



Application No. 10/002,382
Response to Office Action dated November 21, 2005
Amendment dated May 18, 2006

REMARKS

Reconsideration is hereby requested as is a three-month extension of time within which to respond to the outstanding Office Action dated November 21, 2005. Applicant remains a Small Entity.

On Page 2, ¶2 of the outstanding Office Action, all prior rejections were withdrawn in favor of a new rejection, that is, the reference to LaMarra et al (U.S. Patent No. 6,367,761), this, at ¶¶ 3 and 4 of the Official Action, under 35 USC §102 (e) (2) which states "the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,..."

For the reasons, as set forth below, 35 USC §102 (e)(2) is not applicable in this matter because the filing and effective date of LaMarra are not before the invention by the applicant. This is because, as is set forth in the attached declarations and affidavit (Exs. A-C herewith), the present invention was conceived in or about March 1998 (¶2, Memran Dec.), and within a month thereof, the applicant began to actively pursue reduction-to-practice of his invention (¶3, Memran Dec.) By late 1998, applicant had "developed circuit diagrams for the invention and furnished a copy of them to one Eric Buchwald, a businessman in Florida..." (¶4, Memran Dec.) These facts of Memran are

confirmed in the attached declaration of said Buchwald (Ex. B) and the attached affidavit of one James Mann, whose affidavit was previously accepted in this case for another purpose. As such, the facts relative to the 1998 period of Memran are corroborated by the declaration of Buchwald and affidavit of Mann. By January 1999, Memran had constructed "a working computer audio system which used vacuum tubes in series with an output of a sound card of a computer." (§15, Memran Dec.). As such, the invention was actually reduced-to-practice in January 1999.

In view of these facts, it is clear that Memran had not only conceived of his invention prior to the effective date of LaMarra but had also reduced it to practice approximately a year before the effective date of LaMarra. As such, diligence between the events is not an issue here.

In September 2000, Memran and Buchwald, working with said Mann, formed a Florida corporation known as Compu-Tube and began to actively market the invention. There is no evidence or intimation that an abandonment of the invention occurred after January 1999 or before September 2000 or that Memran was not active in attempting to move his invention forward in a commercial sense. Quite to the contrary, the Compu-Tube website was developed in late 2000 (§17 and Ex. 1 Buchwald Dec.) and remains posted today. Therefore, at least by the date of posting of the Compu-Tube website in 2000, Memran and his colleagues had been active in advancing the invention. The fact

of the meeting in late 1999 between Buchwald and Mann and Memran's close association with Buchwald is reflected in Mann's affidavit (§§3-5 Mann Aff.). On November 1, 2000, Applicant filed his Provisional Application Serial No. 60/245,285, which corresponded substantially identically in subject matter to the present pending application. See filing Receipt of Ex. D herewith. Accordingly, applicant filed for patent well within the §102(a) and §102(b) periods regarding the publication of his website. As such, Memran was not statutorily barred from filing his Provisional Application on November 1, 2000 or converting the same into the present pending Utility Application No. 10/002,382 on October 20, 2001 or claiming the §119(e) priority date of the provisional, which he did. As Memran notes in ¶7 of his declaration, "These applications reflect my invention as conceived in 1998 and reduced-to-practice in 1999. "

In view of the above, 35 USC §102 (e)(2) cannot sustain a basis of rejection because the 2000 application which matured into the LaMarra patent was not filed before the invention by the applicant which, as noted, had already been reduced-to-practice by January 1999.

On Page 4, ¶5 of the Official Action, the Examiner notes that "the prior art made of record and not relied upon is considered pertinent to the applicant's disclosure." In connection therewith, applicant notes that the reference to Fay, namely, U.S.. Patent No. 6,150,599, issued twenty days after the filing date of Applicant's provisional application and was filed February 2, 1999, that is, approximately one month after Applicant's actual reduction-to-practice and well

after applicant's constructive reduction to practice by generation of the "circuit diagrams of the invention" (§4, Memran Dec.) which occurred by late 1998. Clearly, if cited as a basis of rejection, applicant will assert priority of invention as set forth above. Other references cited by the Examiner, namely, Sutherland, Chang and Girard, had effective dates of 2001 and 2002, and Girard derived from a continuation of a PCT application filed in France on February 14, 2000. Neither this date nor the date of Girard's French priority application (September 15, 1999) would be prior to the date of applicant's actual reduction-to-practice in January 1999. As such, Girard did not invent prior to applicant such that §102(e)(1) would not be applicable. The same is true of Chang and Sutherland.

In view of the above, applicant was first to invent with respect to any art-of-record inclusive of LaMarra, Fay, Sutherland, Chang and Girard and, as such, the early allowance of this application is appropriate.

Respectfully submitted,
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Enclosures:

- Ex. A: Declaration of Memran.
- Ex. B: Declaration of Buchwald.
- Ex. C: Affidavit of Mann.
- Ex. D: Filing Receipt showing claim to priority or provisional application.